Remarks

Status of Claims

Upon entry of this amendment, claims 1-5 and 11are pending. Claims 1-4 have been amended. Claim 5 is original. Claims 6, 7, 9 and 10 are withdrawn. Claim 8 is cancelled. Claim 11 is new.

Claims Amendments:

Claims 1-4 have been amended to in accordance to the restriction/election requirement. Claim 11 is new and does not add new matter.

Restriction/Election Requirement:

The Examiner has required a Restriction/Election under 35 U.S.C 121 and 372. Specifically, the Examiner has required an election from (see Office Action, page 2):

Group I, the instances wherein each Y is C, R_2, R_3 are aryl or cycloalkyl and R_4- R_{10} represent non-heterocyclic groups.

Group II, the instances wherein one Y is N and the other is C which form a pyrid-3-yl, R_2, R_3 are aryl or cycloalkyl and R_4- R_{10} represent non-heterocyclic groups.

Group III, the instances wherein each Y is C, R_2 is aryl or cycloalkyl, R_3 is benzooxaz-2-yl and R_4- R_{10} represent non-heterocyclic groups.

Group IV, the instances wherein one Y is N and the other is C which form a pyrid-3-yl, R_2 is aryl or cycloalkyl, R_3 is pyrid-2-yl and R_4- R_{10} represent non-heterocyclic groups.

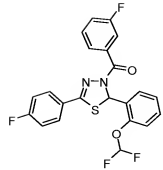
Group V, any compounds not grouped in the above groups because claim 1 is too vague to further group.

Group VI, Claims 6, 7 and 9, drawn to multiple uses.

Group VII, Claim 10, drawn multiple uses requiring an additional active ingredient.

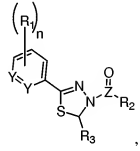
For each group an election of a single species was requested.

The Applicants herein provisionally elect Group I with traverse and elect the compound depicted in Example 22 as the single species election:



Example 22

With respect to Formula (I), the compound depicted in Example 22 corresponds to the following:



,

wherein,

n is 1;

Z is C;

each Y is independently selected from $-CR_4=$; wherein R_4 is hydrogen;

R_1 is selected from halo;

R_2 is selected from $C_{6\text{-}10}$aryl substituted with halo;

R_3 is selected from $C_{6\text{-}10}$aryl, substituted with halo-substituted-$C_{1\text{-}6}$alkoxy

The claims encompassing the elected group are claims 1-5 and 11.

Restriction/Election with Traverse:

The Applicants respectfully disagree with the Restriction/Election Requirement, wherein the Office Action asserts that (see Office Action page 2):

> "This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1."

The Office Action further asserts that (see Office Action page 3):

> "The claims herein lack unity of invention under PCT Rule 13.1 and 13.2 since the compounds defined in the claims lack a significant structural element qualifying as the special technical feature that defines a contribution over the prior art."

The Applicants respectfully disagree and respectfully assert that according to the MPEP, section 1850 (emphasis added):

> "The expression "special technical features" is defined in PCT Rule 13.2 as meaning those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art. The determination is made on the contents of the claims as interpreted in light of the description and drawings (if any)."

and similarly C.F.R § 1.475 (a) states that (emphasis added):

> "An international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art."

The Applicants respectfully assert that the "special technical feature" linking the different categories of inventions of the instant application is that the compounds of formula (I) of the instant application are LXR agonists. Furthermore, the Applicants respectfully assert that different categories of inventions of the instant application are drawn to the combination recited in C.F.R § 1.475 (b)(2). Specifically, C.F.R § 1.475 (b) states that:

> "(b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:
>
> (1) A product and a process specially adapted for the manufacture of said product; or
> (2) A product and process of use of said product; or
> (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
> (4) A process and an apparatus or means specifically designed for carrying out the said process; or
> (5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process."

Therefore, in view of the above, the Applicants respectfully assert that the use of the compounds of Formula (I) as LXR agonists constitute as the "special technical feature" linking the inventions of the instant application, and thereby the requirement of unity of invention is fulfilled with regards the C.F.R § 1.475 (b)(2).

Additionally, the Applicants respectfully assert that, as defined in PCT Rule 13.2 and C.F.R § 1.475 (a), the qualifying factor for a technical feature is whether the technical feature makes a "contribution over the prior art". In this regard, the Applicants respectfully assert that the Examiner has not cited any prior art, thereby showing that compounds of Formula (I) of the instant claims do not make a contribution over the prior art. Accordingly, the Applicants respectfully assert that the Restriction/Election under 35 U.S.C 121 and 372 is improper and respectfully request withdrawal of the Restriction/Election requirement.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants believe all claims now pending in this Application are in condition for allowance. Although, reconsideration of the Restriction/Election Requirement is respectfully requested.

It is believed that no fees are necessary in connection with this paper, however if this is incorrect and additional fees are due, or additional extensions of time are necessary to prevent abandonment of this application, then the U.S. Patent and Trademark Office is authorized to deduct any requisite fees from, or deposit any overpayment into, Deposit Account **No. 50-1885** referencing docket PAT034395-US-PCT.

If the Examiner believes a telephone conference would expedite prosecution of this application, the Examiner is respectfully requested to contact the undersigned at the telephone number below.

Respectfully submitted,

Date: May 12, 2011 /Daniel E. Raymond, Reg. # 53,504/

Daniel E. Raymond

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